



PATENT

Attorney Docket No. 66043

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Rodrigo F. CHUAQUI et al.
Appln No.: 09/743,825
Filed: July 23, 1999
For: PB 30, A GENE
DYSREGULATED IN PROSTATE
CANCER, AND USES THEREOF
Group Art
Unit:
Examiner:

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on this date.

11/23/01

Date

Richard A. Kaba

Registration No. 30,562

Attorney for Applicant(s)

RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS

Box MISSING PARTS
Commissioner of Patents and Trademarks
ATTENTION: Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Notice to File Missing Parts dated May 22, 2001, enclosed are:

- ☒ A copy of the Notice to File Missing Parts.
- ☒ An executed Declaration for Patent Application, including Power of Attorney.
- ☐ _____ sheet(s) of drawings are enclosed. ☐ Formal ☐ Informal
- ☐ An Assignment of the invention to _____, and Recordation Form Cover Sheet - Patents Only - Form PTO-1595.
- ☐ A check in the amount of \$_____ to cover the fee for recording the assignment.
- ☐ The Recordation Form Cover Sheet includes authorization to charge our Deposit Account for recording the assignment.

☒ Fee Calculation:

Fee Calculation For Claims As Filed

<input type="checkbox"/> Provisional Application Basic Fee	\$160.00	
Surcharge under 37 C.F.R. §1.16(1)	\$ 50.00	
<input checked="" type="checkbox"/> Non-Provisional Utility Application Basic Fee	\$ 740.00	
Independent Claims	$\frac{3}{20} = \frac{0}{0} \times \$ 84.00 = \$ 0.00$	
Total Claims	$\frac{20}{20} = \frac{0}{0} \times \$ 18.00 = \$ 0.00$	
Fee for Multiply Dependent Claims	\$ 280.00	
Surcharge under 37 C.F.R. §1.16(e)	\$ 130.00	\$ 130.00
<input type="checkbox"/> Design Application Basic Fee	\$ 330.00	
Surcharge under 37 C.F.R. §1.16(e)	\$ 130.00	
Total Filing and/or Surcharge Fee		\$ 130.00

☐ Applicant(s) assert entitlement to Small Entity Status, reducing the Filing/Surcharge Fee by half to: \$


☐ A check in the amount of \$_____ to cover the Filing and/or Surcharge Fee.

☒ Charge \$ 130.00 to Deposit Account No. 06-1135.

☒ The Commissioner is hereby authorized to charge any additional fees which may be required in this application under 37 C.F.R. §§1.16-1.17 during its entire pendency, or credit any overpayment, to Deposit Account No. 06-1135. Should no proper payment be enclosed herewith, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1135. This sheet is filed in triplicate.

01/23/2002 MNGUYEN 00000012 061135 09743825

02 FC:154 130.00 CH
November 23, 2001
 Date


 Richard A. Kaba
 Registration No. 30,562

FITCH, EVEN, TABIN & FLANNERY
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 120 South LaSalle Street
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 Facsimile: (312) 577-7007



PATENT
ATTORNEY DOCKET
NO. 66043

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Chuaqui et al.

Serial No.: 09/743,825

Filed: July 23, 1999

Title: PB39, A GENE
OVEREXPRESSED IN
PROSTATE CANCER, AND
USES THEREOF

Group Art Unit: Not Yet Assigned

Examiner: Not Yet Assigned

CERTIFICATE OF MAILING

I hereby certify that this paper is
being deposited with the United States
Postal Service as first class mail in an
envelope addressed to: Commissioner of
Patents and Trademarks, Washington, D.C.
20231, on this date

11/23/01
Date Registration No. 30,562
Attorney for Applicant(s)

STATEMENT CONCERNING SEQUENCE LISTING

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Dear Sir:

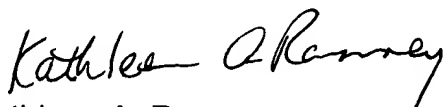
Attached hereto is a computer-readable form of the Sequence
Listing for the above-identified patent application.

I, KATHLEEN A. RANNEY, declare that I personally prepared the
paper and computer-readable copies of the Sequence Listing set forth in the above-

identified case. The computer-readable nucleotide and amino acid sequences are the same as set forth in the Specification of the above-referenced case.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By: 
Kathleen A. Ranney
Registration No. 37,702

Date: November 21, 2001

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MAY 30 2001



UNITED STATES PATENT AND TRADEMARK OFFICE

 Commissioner for Patents, Box PCT
 United States Patent and Trademark Office
 Washington, D.C. 20231
 www.uspto.gov


U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/743825	CHUAQUI	R 66043
INTERNATIONAL APPLICATION NO.		
PCT/US99/16831		
I.A. FILING DATE	PRIORITY DATE	
23 JUL 99	24 JUL 98	

 FITCH TABIN & FLANNERY
 120 SOUTH LASALLE ST SUITE 1600
 CHICAGO, IL 60603 3406

 MUM
 Due 7/22/01

DATE MAILED: 22 MAY 2001

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☒ an Elected Office (37 CFR 1.495):
- | | |
|--|---|
| <input checked="" type="checkbox"/> U.S. Basic National Fee. | <input type="checkbox"/> Indication of Small Entity Status. |
| <input checked="" type="checkbox"/> Copy of the international application. | <input type="checkbox"/> Translation of the international application into English. |
| <input checked="" type="checkbox"/> Oath or Declaration of inventors(s). | <input type="checkbox"/> Translation of Article 19 amendments into English. |
| <input type="checkbox"/> Copy of Article 19 amendments. | <input type="checkbox"/> Other: |
| <input type="checkbox"/> Priority Document. | |
| <input checked="" type="checkbox"/> The International Preliminary Examination Report in English and its Annexes, if any. | |
| <input type="checkbox"/> Translation of Annexes to the International Preliminary Examination Report into English. | |
2. ☐ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.
- | | |
|---|---|
| <input type="checkbox"/> U.S. Basic National Fee. | <input type="checkbox"/> Copy of the international application. |
|---|---|
3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:
- | |
|---|
| <input type="checkbox"/> a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date. |
| <input type="checkbox"/> The current translation is defective for the reasons indicated on the attached Notice of Defective Translation. |
| <input type="checkbox"/> b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)). |
| <input type="checkbox"/> c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date. |
| <input checked="" type="checkbox"/> The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917. |
| <input checked="" type="checkbox"/> d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)). |
4. Additional claim fees of \$_____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.
5. ☒ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.

ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes **MUST** be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.
7. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice *MUST* be returned with this response.

Enclosed: ☒ PCT/DO/EO/917 ☐ Notice of Defective Translation
☐ PTO-875 ☒ PCT/DO/EO/920

Karen Williams

FORM PCT/DO/EO/905 (March 2001)

Telephone: 703-305-3688



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/743825	CHUAQUI	R 66043

FITCH TABIN & FLANNERY
20 SOUTH LASALLE ST SUITE 1600
CHICAGO, IL 60603 3406

INTERNATIONAL APPLICATION NO.

PCT/US99/16831

I.A. FILING DATE	PRIORITY DATE
23 JUL 99	24 JUL 98

DATE MAILED: 22 MAY 2001

NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371(c)(4) for entry into the national stage in the United States of America. The period within which to correct the deficiency noted below and avoid abandonment is set in the accompanying Notification.

A new oath or declaration, properly identifying this application (preferably by the international application number and international filing date) is required. The oath or declaration does not comply with 37 CFR 1.497(a),(b) and (f) in that it:

1. ☒ is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
2. ☐ does not identify the application to which it is directed.
3. ☐ does not identify the inventor(s).
4. ☐ does not identify the citizenship of each inventor.
5. ☐ does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b). AND 1.497(d) WHERE APPROPRIATE, WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.

Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the mailing address of each inventor. If the residence is different from the mailing address, then the city and state or city and foreign country of residence of each inventor must also be given.
2. ☐ does not state that the person making the oath or declaration:
 - a. ☐ has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
 - b. ☐ acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.
3. ☐ does not identify the foreign application for patent or inventor's certificate for which a claim for priority is made pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.

Karen Williams *KW*

Telephone: 703-305-3688



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NO.

09/743825

FIRST NAMED APPLICANT

HUAQUI

ATTY. DOCKET NO.

66043

INTERNATIONAL APPLICATION NO.

PCT/US99/16831

I.A. FILING DATE

23 JUL 99

PRIORITY DATE

24 JUL 98

FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE ST SUITE 1600
CHICAGO, IL 60603 3406

DATE MAILED: 22 MAY 2001

**NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS
CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE
DISCLOSURES**

Applicant has submitted papers under 35 U.S.C. 371 to enter the national stage in the United States of America. The items indicated below, however, are missing. The period within which to correct the deficiency noted below and avoid abandonment is set forth in the accompanying Notification.

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):

- ☒ The application fails to comply with the requirements of 37 CFR 1.821-1.825.
- ☐ This application does not contain, a "Sequence Listing" as a separate part of the disclosure on paper copy or compact disc, as required by 37 CFR 1.821(c).
- ☒ A copy of the "Sequence Listing" in computer readable format has not been submitted as required by 37 CFR 1.821(e).
- ☐ A copy of the "Sequence Listing" in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the "Raw Sequence Listing."
- ☐ The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
- ☐ The paper copy or compact disc of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).
- ☐ Other: _____

APPLICANT MUST PROVIDE:

- ☒ An initial or substitute computer readable form (CRF) of the "Sequence Listing."
- ☐ An initial or substitute paper copy or compact disc of the "Sequence Listing," as well as an amendment directing its entry into the specification.
- ☒ A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).

FOR QUESTIONS REGARDING COMPLIANCE WITH THESE REQUIREMENTS, PLEASE CALL:

(703) 308-4216, for Rules interpretation,
(703) 308-4212, for CRF submission help,
(703) 287-0200, for PatentIn software help.

Karen Williams *KW*

Telephone: 703-305-3688